

REMARKS

Claims 20 to 22 are added, and therefore claims 10 to 22 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As to paragraph two (2) of the Office Action, claims 10 and 13 to 19 are rejected under 35 U.S.C. § 102(b) as anticipated by Asakawa, Japanese Patent No. 02-084119.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 10 is directed to a window-integrated antenna in a vehicle, including at least one decoupling element for at least the LMS reception, the at least one decoupling element including a high-frequency and non-galvanic connection to the heating conductor field, wherein the at least one decoupling element is situated in the heating conductor field between two adjacent heating conductors.

In this regard, the Asakawa reference does not identically disclose (or suggest) the feature of *at least one decoupling element is situated in the heating conductor field between two adjacent heating conductors*, as provided for in the context of the presently

claimed subject matter. As to the Asakawa reference cited in Figures 3 and 5, its Figures 3 and 5 do not identically disclose the feature of a decoupling element situated in the heating conductor field between two adjacent heating conductors. Further, element 24, of Figure 1 does not identically disclose (or suggest) the feature of a decoupling element situated in the heating conductor field between two adjacent heating conductors. In fact (as is evident from Figures 1, 3, and 5 of the Asakawa reference), element 24 is situated above the heating conductor field (as is evidenced by the location of electrodes 3 and 4 in the Figures). Further, the decoupling element is not between two adjacent heating conductors.

Therefore, the device according to the presently claimed subject matter is wholly different than that of the Asakawa reference, which does not identically disclose (nor suggest) the feature of at least one decoupling element is *situated in the heating conductor field between two adjacent heating conductors*, as provided for in the context of the claimed subject matter.

Accordingly, it is respectfully submitted that claim 10 is allowable for at least the reasons provided above, as are its dependent claims 13 to 19.

Withdrawal of the rejections of these claims is therefore respectfully requested.

As to paragraph four (4) of the Office Action, claims 11 and 12 are rejected under 35 U.S.C. § 103(a) as unpatentable over the Asakawa reference.

As explained above, the Asakawa reference does not disclose or even suggest all of the reference features of claim 10, so that it is allowable, as are its dependent claims 11 and 12.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Withdrawal of the obviousness rejections of these claims is therefore respectfully requested.

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New claims 20 to 22 do not add any new matter and are supported by the present application, including the specification. Claims 20 to 22 depend from claim 10, and are therefore allowable at least for the same reasons.

In sum, it is respectfully submitted that claims 10 to 22 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

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Respectfully submitted,
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